

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
Kwasi ASARE, et al.	:	Confirmation Number: 2577
	:	
Application No.: 10/726,192	:	Group Art Unit: 2192
	:	
Filed: December 2, 2003	:	Examiner: T. Dao
	:	
For: HOSTING ENVIRONMENT ABSTRACTION AGENTS	:	

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated September 2, 2008.

The Examiner's response to Appellants' arguments submitted in the Second Appeal Brief of June 17, 2008 (hereinafter the Second Appeal Brief), raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejection. In response, Appellants rely upon the arguments presented in the Second Appeal Brief, and the arguments set forth below.

REMARKS

Non-Compliant Examiner's Answer

On page 4 of the Second Appeal Brief, Appellants pointed out where the Examiner's Answer is required to include particular content discussed in M.P.E.P. § 1207.02, yet the Examiner has completely ignored this requirement. As noted throughout the prosecution of this application and in the Appeal Brief, the Examiner has failed to properly establish the facts underlying the Examiner's analysis. Appellants' position is that these omissions in the Examiner's prima facie analysis are correctable by the Examiner, and the correction of these omissions would help both Appellants and the Honorable Board gain a better understanding of the findings of facts and analysis employed by the Examiner in rejecting the claims. Thus, Appellants respectfully request that the Honorable Board remand the present application to the Examiner to address these omissions.¹

Claim 1

The Examiner's response to the arguments presented on page 5, line 10 through page 6, line 3 of the Second Appeal Brief is found on pages 7 and 8 of the Examiner's Answer. Referring specifically to page 7 of the Examiner's Answer, the Examiner reproduced the passages which the Examiner previously cited in the Third Office Action (i.e., regarding Figs. 7 and 11). The Examiner also referred to a newly-cited figure (i.e., block 614 in Fig. 6). Notably,

¹ The Board has persistently declined to uphold an Examiner because of omissions in the Examiner's half of the record. *E.g.*, Ex parte Dalciden, Appeal 2007-1003 (Mar. 14, 2007) (remanding because examiner failed to respond to arguments in the Appeal Brief); Ex parte Rozzi, 63 USPQ2d 1196, 1200-03 (BPAI 2002) (remanding without decision because of a host of examiner omissions and procedural errors); Ex parte Gambogi, 62 USPQ2d 1209, 1212 (BPAI 2001) ("We decline to tell an examiner precisely how to set out a rejection."); Ex parte Jones, 62 USPQ2d 1206, 1208 (BPAI 2001) (refusing to adjudicate an issue that the examiner has not developed); Ex parte Schricker, 56 USPQ2d 1723, 1725 (BPAI 2000) ("The examiner has left applicant and the board to guess as to the basis of the rejection ... We are not good at guessing; hence, we decline to guess."); Ex parte Bracken, 54 USPQ2d 1110, 1112-13 (BPAI 1999) (noting that the appeal is "not ripe" because of omissions and defects in the examiner's analysis).

each of the Examiner's cited passages refer to assemblies, the importance of which Appellants' will subsequently discuss.

On page 8 of the Examiner's Answer, the Examiner addressed an argument presented by Appellants on page 5, line 16-20 of the Second Appeal Brief. Specifically, Appellants argued the following:

In column 2, lines 33-36, Grier states that "[a] component is often packaged with other components as an assembly, wherein an assembly is set of one or more component files that are versioned and ship as a unit, and thus as used herein a set of one or more components are also referred to as an assembly" (emphasis added). Thus, based upon the unambiguous teachings of Grier, an assembly (i.e., one assembly) is the set of components. (emphasis in original)

In response to these arguments the Examiner reproduced certain cited passages within Grier and asserted the following:

The examiner respectfully disagrees. As consistently set forth in the previous Office action, Grier teaches a set of assemblies as "*a set of components in an application*" (emphasis added).

The Examiner's analysis turns a blind eye to the clear and unambiguous teaching (previously identified by Appellants) on column 2, lines 36-37 that:

as used herein a set of one or more components are also referred to as an assembly.

Thus, Grier teaches that an assembly is a set of components. Therefore, when Grier teaches that dependencies between assemblies are identified, Grier does not explicitly or inherently teach that dependencies between components are identified. Instead, Grier teaches that dependencies between sets of components (i.e., assemblies) are identified.

1 The Examiner's analysis appears to be relying upon an unstated inherency argument.
2 Specifically, the Examiner appears to be asserting that since an assembly could include a single
3 component and if a second assembly also includes a single component, and if a dependency
4 exists between these two assemblies, then Grier could 'inherently' teach the claimed "identifying
5 dependencies between each component in said set." Such a reliance upon the doctrine of
6 inherency, however, would be misplaced.

7
8 Inherency may not be established by probabilities or possibilities. The mere fact that a
9 certain thing may result from a given set of circumstances is not sufficient to establish
10 inherency.² To establish inherency, the extrinsic evidence must make clear that the missing
11 element must necessarily be present in the thing described in the reference, and that the necessity
12 of the feature's presence would be so recognized by persons of ordinary skill.³ This burden has
13 not been met.

14
15 Although a single set of circumstances exist, which may result in Grier teaching the
16 claimed invention, the missing limitations are not necessarily present within the teachings of
17 Grier. For example, if any assembly included two or more components (a circumstance
18 specifically contemplated by Grier), then Grier does not teach that dependencies between each
19 component in the set are identified since Grier only teaches identifying dependencies between
20 assemblies and not components. Therefore, the Examiner cannot properly assert that the

² In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

³ Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990).

limitation at issue is inherently disclosed by Grier. Since Grier fails to explicitly teach identifying dependencies between each component in a set, Grier fails to identically disclose, within the meaning of 35 U.S.C. § 102, all of the limitations recited in claim 1.

The Examiner further addressed the claimed "identifying dependencies between each component in said set" in subsection "b)" on pages 8 and 9 of the Examiner's Answer. Notably, in the first full paragraph on page 9 of the Examiner's Answer, the Examiner asserted the following:

In the Office action, "*assemblies*" in Grier (col.7: 30-33 and col.11: 14-30 as recited above) have been consistently equated with the claimed limitation "*components*" in the instant application. As acknowledged by the Appellants, the "*cited passage describes dependencies between assemblies*", which indeed describes/teaches "*identifying dependencies between each component in said set*" (emphasis in original)

As readily apparent from the above-reproduced statement, the Examiner's analysis is not based upon establishing Grier identically discloses all of the claimed limitations, as those limitations would be construed by one skilled in the art. Instead, the Examiner's analysis involves construing the language of the claims in a manner inconsistent with how one having ordinary skill in the art would construe the language of the claims.

The issue of claim construction is discussed in M.P.E.P. § 2111, entitled "Claim Construction; Broadest Reasonable Interpretation," a portion of which is reproduced below:

During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000) ... The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

1 The language of claim 1 specifically refers to "components." The teachings of Grier also
2 specifically refer to "components" consistent with Appellants' use of the term "components."
3 Thus, both Grier and Appellants use the term "components" to mean the same thing. The
4 Examiner, however, has improperly redefined the claimed "components" to mean "assembly," so
5 as to assert that the "assembly" taught by Grier identically discloses the claimed "component."
6 Appellants' position is that this interpretation of the language of the claims is inconsistent with
7 the interpretation that one skilled in the art would reach. Thus, the Examiner has committed
8 reversible error by improperly construing the language of the claims.

11 The Examiner's response to the arguments presented on page 6, line 22 through page 7,
12 line 13 of the Second Appeal Brief is found on pages 9-11 of the Examiner's Answer under
13 subsection "c)". The Examiner's citations and assertions, however, fail to address the substance
14 of the arguments presented on pages 6 and 7 of the Second Appeal Brief.

16 For example, Appellants' recognize that Fig. 8 is a dependency graph showing
17 dependencies between assemblies. Appellants do not disagree that Fig. 8 could also be
18 considered as including a hierarchical structure. However, as noted in the Second Appeal Brief,
19 the Examiner's cited passages (i.e., "FIG. 2A-B, Manifests 214 and 215, col.11: 14 — col.12:
20 57; FIG. 3A-B, Application Manifest 204, col.16: 4-39") do not refer to the dependency
21 graph of Fig. 8.

1 In particular, reference is made to column 8, lines 1-21 of Grier. This passage
2 describes the application manifest and the contents thereof. Although the application
3 manifest includes "an application's dependencies on shareable assembly versions," this
4 application does not include the dependencies (shown in Fig. 8) between assemblies (i.e.,
5 allegedly corresponding to the claimed components) within the application manifest.

6
7 As noted above, the Examiner's analysis is relying upon either "Manifests 214 and
8 215" or "Application Manifest 204" as identically disclosing the claimed "model
9 encapsulating said hierarchical structure." Referring to page 11 of the Examiner's
10 Answer, the Examiner also asserted the following:

11 FIG. 6, block 600 "Any Application Manifest" - "YES" - block 610 "Build Partial-
12 Dependency Graph from Application Manifest", emphasis added, i.e., application manifest (an
13 XML formatted document/a model) encapsulating a dependency graph (a hierarchical structure)
14

15 By the Examiner's own analysis and cited passage, the Examiner has explained why the
16 "manifest" of Grier does not identically disclose the claimed "model encapsulating said
17 hierarchical structure."

18
19 Specifically, block 610 in Fig. 6 describes that the partial-dependency graph (i.e., Fig. 8)
20 is built from the application manifest. Although the dependency graph may be built, in part,
21 from information within "the application manifest, configurations and any assembly manifest"
22 (column 20, lines 36-37), the hierarchical structure is formed outside and separate from the
23 application manifest. Thus, the application manifest does not include the dependency graph in
24 Fig. 8 of Grier and fails to identically disclose the claimed "model encapsulating said
25 hierarchical structure." Therefore, Grier fails to identically disclose, within the meaning of 35
26 U.S.C. § 102, all of the limitations recited in claim 1.

1
2
3 The Examiner's response to the arguments presented on page 7, line 15 through page 8,
4 line 16 of the Second Appeal Brief is found on pages 11-13 of the Examiner's Answer under
5 subsection "c)". Yet again, The Examiner's citations and assertions fail to address the substance
6 of the arguments presented on pages 7 and 8 of the Second Appeal Brief.

7
8 As claimed, "data and method member references to other ones of said components in
9 said set [are inspected with] said references indicating a dependency." The Examiner's cited
10 passages describe, e.g., "version data," "name and version of the assembly," "data member
11 references." However, the Examiner has still failed to specifically and unambiguously identify a
12 teaching within Grier that identically discloses the claimed "said references indicating a
13 dependency." As argued in the Second Appeal Brief, the Examiner's cited passages, although
14 separately teaching limitations as to dependencies and "data and method member references" fail
15 to teach the features, as arranged in the claim. Thus, Grier further fails to identically disclose,
16 within the meaning of 35 U.S.C. § 102, all of the limitations recited in claim 1.

17
18 Claim 2

19 The Examiner's response to the arguments presented on page 8, line 18 through page 9,
20 line 2 of the Second Appeal Brief is found on page 13 of the Examiner's Answer and is
21 reproduced below:

22 Grier also discloses "identifying dependencies between target platform resources and
23 said components in said set; and, recording said further identified dependencies in said model"
24 (wherein col.8: 1-21 discloses "privatized assemblies" (col.8: 6), which distinguish with
25 shared assemblies (col.8: 32-36) as different target platform resources; and wherein col.20: 48
26 — col.21: 10 discloses a plurality of "publisher configuration" (col.20: 48-52) as different

1 publishers/vendors, i.e., target platform resources). (emphasis in original)

2
3 The Examiner's analysis implies that the claimed "target platform resources" are identically
4 disclosed by "privatized assemblies."

5
6 To arrive at this conclusion, the Examiner must have employed an (unstated) claim
7 construction for the term "target platform resources" that is entirely inconsistent with a claim
8 construction that would be reached by one having ordinary skill in the art. Referring to
9 paragraph [0024] of Appellants' disclosure, a "target platform" is the platform that is being
10 targeted for the installation of the application (i.e., an application is installed on the target
11 platform). Thus, a target platform resource is a resource of the target platform.

12
13 The Examiner's "privatized assembly," however, is not a target platform resource.
14 Instead, the "privatized assembly" is one of two subsets of assemblies (i.e., "one or more
15 components"). Specifically, a "privatized assembly" is a "simply-named" (ambiguously-named)
16 assembly. The other subset of assemblies refers to assemblies with a strong (or unambiguous)
17 name. Whereas the claimed resource is related to the target platform, the assemblies are related
18 to an application. Thus, Grier further fails to identically disclose, within the meaning of 35
19 U.S.C. § 102, all of the limitations recited in claim 2.

20
21 Claim 4

22 The Examiner's response to the arguments presented on page 9, lines 4-11 of the Second
23 Appeal Brief is found on pages 13 and 14 of the Examiner's Answer. The Examiner's
24 "response," however, is non-responsive. The Examiner simply repeats much of what the
25 Examiner already stated in the Fourth Office Action with the two additional assertions of "data

and method member references as 'fields', 'DLL name', 'pathname', caller/callee" and "policies and different publishers/vendors with different target platform resources." This additional "analysis" does not refer to any features that correspond to the claimed "target platform resources" and Appellants are still unclear as to the relevance of the Examiner's cited passages to the specific limitations in claim 4. Thus, Grier further fails to identically disclose, within the meaning of 35 U.S.C. § 102, all of the limitations recited in claim 4.

Claim 5

The Examiner's response to the arguments presented on page 9, lines 13-20 of the Second Appeal Brief is found on page 14 of the Examiner's Answer. In the Examiner's response, the Examiner asserted that the dependency graph of Fig. 8 corresponds to the claimed "hierarchical structure" and that manifests correspond to the claimed "a model encapsulating said hierarchical structure." However, as previously argued, the application manifest does not "encapsulate" the dependency graph of Fig. 8. Instead, the dependency graph of Fig. 8 is built from information contained within the application manifest and *other* sources. Thus application manifest, alone, cannot "encapsulate" the dependency graph of Fig. 8 since all the information needed to create the dependency graph is not found within the application manifest.

Claim 6

The Examiner's response to the arguments presented on page 9, line 22 through page 10, line 6 of the Second Appeal Brief is found on page 15 of the Examiner's Answer. The Examiner's "response," however, is non-responsive. The Examiner simply repeats much of what the Examiner already stated in the Fourth Office Action with the additional assertion of

"wherein said steps subsequent to installing said application in a target platform as illustrated in FIG. 2A, Application 200 installed in Application Folder 202." Fig. 2A of Grier, however, does not describe the order in which steps are performed. As such, the Examiner's only new analysis fails to cure the deficiencies of the Examiner's old analysis.

Claim 7

The Examiner's response to the arguments presented on page 10, lines 8-14 of the Second Appeal Brief is found on page 15 of the Examiner's Answer. The Examiner's "response," however, is non-responsive. The Examiner simply repeats exactly what the Examiner already stated in the Fourth Office Action. Thus, the Examiner has neither presented new analysis nor responded to Appellants' arguments.

For the reasons set forth in the Second Appeal Brief, and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. § 102.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: November 3, 2008

Respectfully submitted,

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CUSTOMER NUMBER 46320